IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	KURZINGER et al.	Examiner:	SAYALA, Chhaya D.
Serial No.:	10/667,559	Group Art Unit:	1761
Filed:	September 27, 2003	Docket No.:	12742.0005USI1
Title:	FLAKE, FEED, ESPECIALLY FOR AQUATIC ANIMALS		

APPELLANT'S BRIEF ON APPEAL

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Brief is presented in support of the Appeal filed November 30, 2005, from the final rejection of Claims 1-10 of the above-identified application, as set forth in the Office Action mailed May 31, 2005.

Please charge Deposit Account No. 13-2725 in the amount of $500.00 to cover the required fee for filing this Brief. A fee of $450.00 for a two-month extension of time should also be charged to the above account. A duplicate copy of the Transmittal Sheet is attached for this purpose.

I. REAL PARTY OF INTEREST

The real party of interest is Tetra Holdings (US) Inc. by way of assignment from the inventors recorded on February 28, 2005 in Reel/Frame: 016327/0033.

II. RELATED APPEALS AND INTERFERENCES

None.

III. STATUS OF CLAIMS

Claims 1-10 are the pending claims in the present application and stand rejected. Claims 11-22 were canceled without prejudice as non-elected subject matter. Claims 1-10 are being appealed and a copy thereof is at the CLAIMS APPENDIX.

IV. STATUS OF AMENDMENTS

An Amendment after Final rejection was filed on July 28, 2005 accompanied by a Terminal Disclaimer and appropriate fee. The Amendment was entered as noted in the Advisory Action mailed on August 12, 2005.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The subject matter of the present invention as defined in claim 1 is related to a flaked feed for aquatic animals; i.e, fish food, in the form of uniformed flaked bodies, having a water content of from 1-30% and a variable thickness from 10-350 μm.

The term "flake feeds, for aquatic animals" is defined in the specification at page 2 beginning on line 20, to include fish, shrimps, and invertebrates, which can be used in both fresh and sea water, in aquariums, garden ponds and the like and include warm and cold water ornamental fish. The thickness of the flakes include a preferred range of 10-350μm, page 2, line 20. The invention is again defined on page 3 and includes the water content for the flaked feed of from 1-30%. The term "Uniform flake form" is defined further on page 3, lines 25-27. It is also clear from the specification that the process used to prepare the claimed fish feed is responsible for providing the uniformed flaked form having the specified water content and dimensions, thickness and diameter. The diameter limitations defined are in dependent claim 2, based on the language on page 3, line 30.

Claims 2-8 are composition claims dependent on claim 1, while claims 9 and 10 are method of use claims dependent ultimately dependent on claim 1.

The preparation of uniformed flaked feed of variable thicknesses within the claimed range are described in working examples 1-3.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over GB 768189 in view of EP 0337573, Kim (U.S. Patent 5773051), Bunch (U.S. Patent 5618574) and Baensch (U.S. Patent 3796812).

VII. ARGUMENT

A. Rejection of Claim 1-10 under 35 U.S.C. 103(a) Over GB 768189 in view of EP 0337573, Kim (US Patent 5773051), Bunch (US Patent 5618574) and Baensch (US Patent 3796812) Should Be Reversed

(i) The Picking and Choosing of Elements from Five References Amounts to Hindsight Reconstruction of the Claimed Invention

None of the references cited in the rejection alone or in combination teaches or suggests all of the elements of the claimed invention which includes: a uniform body, which is flaked, as a fish feed, having a water content of 1-30% and a thickness of 10-350μm. The examiner has picked and chosen elements from five references, two of which are unrelated to fish food, to arrive at the claimed invention.

The Examiner may not pick and choose from isolated disclosures in order to find the claimed invention obvious. *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988). Prior art references that involve different fields of endeavor than the claimed invention are considered non-analogous art. *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). The combination of elements from non-analogous references is nothing more than improper hindsight reconstruction, which cannot be used to reject claims under 35 USC 103. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1993).

In particular, the primary reference, GB 768189, ('189), does not describe fish feed. The feed is for animals, particularly fowls. Certainly, fowls do not eat the same type of food, nor in the same environment, and not in the same manner as fish. More importantly, the thickness of the flakes in the '189 patent are higher than the claimed range, 0.5 – 1.5mm, (500 to 1500μm) page 2, col. 1, line 24.

The first secondary reference, EP '573 also does not describe fish feed. The feed is a pet food, particularly for dogs and cats. Dogs and cats normally eat out of bowls and not underwater picking food that might be floating or near the top of an aquarium. The feed described for dogs and cats are also clearly distinct in nature from fish food. Although, the thickness of the flakes slightly overlap at the higher range, there is no specific teaching of a water content other than the blank statement: "suitable moisture content", page 2, line 36. The term "suitable" is vague and indefinite and provides no guidance to the skilled person in the relevant art.

The second secondary reference describes fish feed, the Kim patent. Kim teaches flaked fish feed having a water content of 15-25%, within the claimed range but does not describe a thickness within the claimed range. The examiner erroneously referred to the diameter of 1-10mm, "in thickness". This is not thickness. Kim discloses thickness as 0.5mm,(500μm), column 2, line 32. Lines 31 and 32 describe the complete dimensions as a diameter of 1-10mm, thickness of 0.5mm and 15mm in length. The present application describes a range of 1-100mm in diameter at page 3 of the specification and in claim 2. In addition, Kim does not teach that the flakes are or need to be uniform. Kim is mainly concerned about fish food that initially sinks then refloats. See col. 2 line 55 to col. 3, line 4.

Baensch describes a fish food, which overlaps at the high range of thickness where the feed is made of at least one flexible sheet, col. 1, lines 60-62. Later in column 1 and the top of column 2, Baensch is not concerned with uniformed bodies. Baensch states: "However, the present invention is not limited to a specific configuration of the feed bodies, so that, if desired, also irregular shaped feed body sheets may be employed." Col. 1, line 70 to Col. 2, line 2. Baensch is also silent with regard to water content.

Finally, Bunch provides no disclosure with regard to the claimed invention except for recognizing in the Background Art section of the patent, col. 1, that flaked fish foods, among others, were known commercially and recognizing: "Such commercial fish foods suffer from a number of disadvantages" (Col. 1, lines 27-29). No further details are provided with regard to the flaked fish foods. In fact, the Bunch invention is directed to the discovery that a fish food "comprising preserved immature insects, i.e., insect larvae or pupae or other immature forms ... is surprisingly effective in improving the growth rate and coloration of fish" (Col. 2, lines 26-31). Thus, Bunch cannot be combined with the other references and actually teaches away from the subject matter of the other references cited by the Examiner and certainly teaches away from the present invention as claimed.

In order to suggest the present invention as claimed, one needs to combine the uniform bodies of a food for fowl, the thickness of cat or dog food and the water content of a fish food disregarding the entire references teachings which would not suggest a combination. On this basis, the rejection of claims 10 is erroneous as applying hindsight reconstruction.

(ii) There is No Suggestion or Motivation to Combine the Five References

The GB primary reference and the EP secondary reference are not related to fish feed. The Kim fish feed has a greater thickness and requires no uniform bodies. Baensch also does not require uniform shaped bodies and does not specify any moisture or water content. Finally, the Bunch fish food is clearly not relevant to the claimed invention and teaches away from the present invention. Thus it is clear that there is no suggestion or motivation to combine these

references to render obvious the claimed invention. Reversal of the Examiner's rejection is warranted.

The Examiner has combined art from fish feed with land animal feed by relying on the proposition that intended use of an otherwise old or obvious composition cannot render a claim patentable, citing *In re Zierden*, 162 USPQ 102. This contention ignores the preamble and functional language of the claim which are essential parts of the present invention.

Terms in the preamble of a claim that limit the structure or function of the claimed invention are considered part of the invention. *See, e.g., Corning Glass Works v. Sumitomo Elec. USA, Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989). Where the preamble helps define the invention as embodied in the specification and the prosecution history, it acts as a limitation of the claim. *See In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1346 (Fed. Cir. 2002). If the preamble is a statement of the intentional purpose of the invention, and not just a recitation of one possible use, the preamble is limiting and must be considered an element of the invention. *See Jansen v. Rexall Sundown, Inc.*, 342 F.2d 1329, 1333 (Fed. Cir. 2003). An applicant's reliance on the preamble of a claim to distinguish the invention over the prior art transforms an intended use into a claim limitation (i.e. converts the intended use into an element of the claim). *See Metabolite Labs., Inc. v. Corp. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1358–62 (Fed. Cir. 2004); *Catalina Mktg., Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 809 (Fed. Cir. 2002).

The Examiner has correctly relied on the proposition that art need not expressly teach the invention claimed but can fairly suggest the invention, citing *In re Burckel.* A prior art reference can be used to establish obviousness not only based on what it expressly teaches, but also based on what it fairly suggests. *See In re Baird*, 16 F.3d 380, 383 (quoting *In re Burckel*, 592 F.2d

1175, 1179 (C.C.P.A. 1979)). To establish a prima facie case of obviousness, the Examiner must show that the prior art fairly suggests that its teachings should be combined with other prior art. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). The Examiner has the burden to establish why references can be properly combined. The Examiner has not met this burden with regard to all elements of the invention claimed but has remarked only with regard to the moisture content of the feed.

Where a prior art reference teaches away from the claimed invention, the suggestion to combine references is absent. *See In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988). This applies to the Bunch reference. For example, where a cited prior art reference contains no suggestion how to apply its teachings to a particular structure or function disclosed in another prior art reference, there is no motivation to combine. *See In re Bell*, 991 F.2d 781, 784 (Fed. Cir. 1994). This applies to Baensch and the two land animal art, GB and EP references. If the prior art references are from different fields of invention, or deal with unrelated subject matter, or solve different problems, there is probably no motivation to combine the references. *See, e.g., In re Johnston*, 435 F.3d 1381 (Fed. Cir. 2006). This also applies to the GB and EP references.

B. Claims 9 and 10 Are Separately Patentable

Claim 9, if made independent with the scope of claim 1, and claim 10, dependent on claim 9 should be considered separately since they are directed to method of use and not compositions.

Claims to a method of use are separately patentable over claims to a composition. *See, e.g., Merck & Co. v. Teva Pharms., Ltd.*, 347 F.3d 1367, 1372 (Fed. Cir. 2003). In order to be

patentable, the method claims still must meet the usual standards for patenting, such as novelty and non-obviousness. In determining whether a claimed method of use is obvious, the novelty or nonobviousness of the composition is not relevant. Rather, the Examiner must determine if the claimed method of use would have been obvious to one of skill in the art. *See In re Dillon*, 892 F.2d 1554, 1570 (Fed. Cir. 1989).

None of the references cited would motivate or suggest the skilled man to the method claimed for the same reasons as mentioned above. First of all, the GB and EP references are not describing fish feed. Bunch teaches away from the method of the present invention. Kim does not require uniform bodies and has flakes of greater thickness. Baensch also does not require uniform bodies and does not mention any moisture or water content. Thus the references even in combination fail to teach the method claimed.

SUMMARY

In view of the above arguments, Appellants' claimed invention is unobvious over the five references applied in combination, GB 768189 in view of EP 0337573, Kim (US Patent 5773051), Bunch (US Patent 5618574) and Baensch (US 3796812). There is no suggestion or motivation to combine the five references to make the composition and use thereof as claimed in the present application. Furthermore, the picking and choosing of elements of the five references amounts to nothing more than an attempt at hindsight reconstruction of the claimed invention in the present application.

It is earnestly requested that the Examiner's rejection be reversed, and that all of the pending claims be allowed.

Please charge any additional fees or credit overpayment to Merchant & Gould Deposit Account No. 13-2725.

Respectfully submitted,

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CLAIMS APPENDIX

1. A flaked feed for aquatic animals comprising uniformed flaked bodies of feed for said aquatic animals having a water content of from 1-30% and a variable thickness from 10-350 μm.

2. The flaked feed according to claim 1, wherein the feed contains individual flakes with a diameter of from 1 to 100 mm.

3. The flaked feed according to claim 1, wherein the flakes contain temperature-sensitive substances.

4. The flaked feed according to claim 3, wherein the temperature-sensitive substances are selected from odoriferous and flavoring materials, coloring materials, enzymes, promoters, probiotics, vitamins, color strengtheners, and mixtures thereof.

5. The flaked feed according to claim 4, wherein the probiotics are living bacteria or yeasts.

6. The flaked feed according to claim 4, wherein the promoters are growth promoters, fertility promoters, or mixtures thereof.

7. The flaked feed according to claim 4, wherein the flavoring material is a sugar.

8. The flaked feed according to claim 1, wherein the flakes have a round, oval, corrugated, heart-or fish-shaped form or some other uniform geometrical shape.

9. A method of feeding aquatic animals comprising providing a flaked feed according to claim 1 in fresh or sea water.

10. The method of claim 9, wherein the aquatic animals are fish, shrimps or invertebrates.

EVIDENCE APPENDIX

A. OFFICE ACTIONS AND AMENDMENTS/RESPONSES

None.

B. REFERENCES RELIED UPON BY THE EXAMINER

1. U.S. Patent No. GB 768189
2. U.S. Patent No. EP 0337573
3. U.S. Patent No. 5,773,051
4. U.S. Patent No. 5,618,574
5. U.S. Patent No. 3,796,812

C. REFERENCES CITED BY APPELLANTS

None.

D. CASES CITED IN THE BRIEF

RELATED PROCEEDINGS APPENDIX

None.